

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2309350 BY KEVIN SCRANAGE
TO REGISTER A TRADE MARK IN CLASS 25**

DECISION

1. This is an appeal against a refusal by Mr Pike, the Hearing Officer acting for the Registrar, to allow the registration of the trade mark FOOK in Class 25 in respect of clothing, footwear and headgear.
2. The Hearing Officer found that the trade mark was excluded from acceptance by reason of section 3(3)(a) of the Trade Marks Act 1994 on the basis that it consisted exclusively of the word FOOK which is phonetically very similar or, in some regional dialects, identical to the offensive word FUCK. As such it was contrary to accepted principles of morality.

The Law

3. Section 3(3)(a) of the Act implements Article 3(1)(f) of the Trade Marks Directive:
 - “1. The following shall not be registered or if registered shall be liable to be declared invalid:
 - (f) trade marks which are contrary to public policy or to accepted principles of morality;”

This corresponds to Article 7(1)(f) of the Community Trade Mark Regulation.

4. These words were considered by Mr Simon Thorley QC, sitting as the Appointed Person, in *Ghazilian's Application* [2002] ETMR 631. In upholding the decision of the Registrar to refuse registration of the words TINY PENIS as a trade mark in relation to various articles of clothing he said, at paragraph 21:

“... it is only in cases where it is plain that an accepted principle of morality is being offended against that registration should be denied. Mere offence to a section of the public, in the sense that that section of the public would consider the mark distasteful, is not enough.”

And at paragraph 31:

“In my judgment the matter should be approached thus. Each case must be decided on its own facts. The dividing line is to be drawn between offence which amounts only to distaste and offence which would justifiably cause outrage or would be the subject of justifiable censure as being likely significantly to undermine current religious, family or social values. The outrage or censure must be amongst an identifiable section of the public and a higher degree of outrage or censure amongst a small section of the community will no doubt suffice just as lesser outrage or censure amongst a more widespread section of the public will also suffice.”

5. The corresponding words of the Community Trade Mark Regulation were considered by the Fourth Board of Appeal of OHIM in Case R 111/2002-4 *Dick Lexic Limited*, a decision of the 25th March 2003. The Board allowed the registration of the mark DICK & FANNY on the basis that it transmitted no offensive message that could justify the denial of registration on grounds of either public policy or accepted principles of morality, despite the fact that the words might have, in coarse slang, a sexual connotation. It reasoned:

“7 The contested decision was based on the particular meaning of the words in English slang. Yet, as the appellant argues, the same words have another meaning when employed in less informal speech. Dick and Fanny are the diminutive forms of the English first names Richard and Frances (the latter being the feminine version of Francis), respectively. Thus, the words express different meanings depending on

whether standard or informal language is used and the sexual connotation is only present in the latter.

- 8 The Board concedes that the liability of a word mark to the absolute grounds of Article 7(1)(f) CTMR must be assessed on the basis of any usage, not necessarily formal, that the public makes of a given language. Therefore, the meaning of a word in slang may, in principle, lead to an objection, even if in normal usage it does not have an unfavourable connotation.
- 9 However, the Board doubts that the mere fact that the two words have, alone or in combination with each other, a sexual connotation should be regarded as 'offensive' and that it justifies the rejection of the mark on account of public policy or accepted principles of morality. There are two reasons for this : firstly, these words merely designate things but they do not transmit any message; secondly the association of the two words does not necessarily reinforce the connotation of the mark.
- 10 As regards the first reason, the words admittedly designate, in a particularly inelegant (or tasteless) manner, anatomical parts that are rarely mentioned in ordinary speech – whether formal or informal. In principle, the mark does not proclaim an opinion, it contains no incitement, and conveys no insult. In the Board's opinion, in these circumstances, the mark should not be regarded as contrary to either public policy or accepted principles of morality. For this reason, the Board would agree with the appellant that the mark may, at most, raise a question of taste, but not one of public policy or morality.
- 11 As regards the second reason, the Board denies that the association of the two words reinforces the sexual connotation of the mark. There would be good arguments in support of the opposite view as well. As a combination of the diminutive form of forenames, the association of 'Dick' with 'Fanny' could, in fact, reduce that connotation and allude instead to a couple. This sort of combination of names, particularly in their diminutive form, is rather widespread even in an English-language context (Tom & Jerry, Bonnie & Clyde, to name just a few).
- 12 All in all, the Board considers that the mark has, in non-formal English usage, a rather smutty flavour but, since it does not convey any additional message and has a

neutral meaning in formal English usage, it falls short of being contrary to public policy or accepted principles of morality.”

6. The Board considered that a mark is not contrary to public policy or accepted principles of morality merely because it carries a sexual connotation or innuendo. Nor is it enough to refuse registration that the mark may be perceived to be smutty or in bad taste. Further, in making the assessment it is relevant to consider whether the mark proclaims an opinion, contains an incitement or conveys an insult.
7. In *Jesus Trade Mark*, decision 0-021-05 dated 18 January 2005, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, emphasised that these prohibitions must be interpreted consistently with the provisions of the European Convention on Human Rights and the right to freedom of expression. Under Article 10 the right to freedom of expression is exercisable subject only to:

“such formalities, conditions, restrictions or penalties as are prescribed by law and are necessary in a democratic society ... for the prevention of disorder or crime, the protection of health or morals ...”
8. I do not detect any aspect of the reasoning in *Ghazilian* or in *Dick Lexic* which is inconsistent with Article 10 of the European Convention on Human Rights. Registration is not to be refused on the grounds of taste. For the prohibition to operate a mark must be one which will justifiably cause outrage or be the subject of justifiable censure as being likely significantly to undermine current religious, family or social values.

The appeal

9. In his written submissions and in the course of argument the appellant accepted, as was inevitable, that in various different regions of the United Kingdom the word FOOK is phonetically indistinguishable from the word FUCK. Indeed, the fact that the mark is, to many, phonetically indistinguishable from the word FUCK is, I have no doubt, one of the reasons it was chosen by the appellant. Nevertheless, he submitted, the word FUCK

and other swear words are now often used and accepted in everyday conversation and expression and therefore ought to be allowed to proceed to registration. As illustrations of such usage and acceptance, I was referred to the recent film title "*Meet the Fockers*" and the well known High Street brand "FCUK".

10. To my mind, however, the acceptance by the appellant that the word FOOK would be pronounced FUCK in various different regions of the United Kingdom places an insuperable difficulty in the path of the application for the following reasons.
11. First, I have no doubt that it would not be appropriate to allow registration of the word FUCK. Although it may be used commonly it is, nevertheless, a swear word and deeply offensive and insulting to many people. It is more than distasteful or smutty. The general use of the word is likely to cause justifiable outrage amongst a significant section of the public. I can see no justification based on the right to freedom of expression or otherwise to allow such a word to proceed to registration.
12. Secondly, trade marks on t-shirts and other garments are frequently referred to orally and may be advertised by radio, recommended by word of mouth or asked for in a shop. There is therefore ample scope for the mark FOOK to be used in circumstances where it would be indistinguishable from the word FUCK. Accordingly I believe that the mark FOOK has, at least in oral use, the same capacity to cause offence and outrage as the word FUCK. In the context of this application such oral use cannot be disregarded.
13. The Hearing Officer concluded that the use of the word FOOK as a trade mark in relation to the goods for which registration is sought would cause greater offence than mere distaste to a significant section of the general public. I agree with him. The mark is excluded from acceptance by section 3(3)(a) of the Act.

14. The Appeal must accordingly be dismissed. I was invited to make no order as to costs.

David Kitchin QC

23 June 2005

Mr Willmot of The Trade Marks Bureau appeared on behalf of the applicant

Mr Morgan appeared on behalf of the Registrar